

Remarks

Claims 1-17 are currently pending in the above-captioned matter. Claims 15-17 are withdrawn from consideration; please cancel claims 15-17 without prejudice. New claims 18 and 19 have been added hereby. Support for the new claims is found at page 8, line 3-26, page 10, line 34 to page 11, line 11. Claim 7 has been amended to correct an error in the ratio, see bottom of page 9 to top of page 10. No new matter has been added.

After entry of this amendment, claims 1-14, 18 and 19 are pending. Claims 1-14 are rejected. Remarks made herein are based on the claims as amended hereby.

35 U.S.C. §112 Rejections

Claim 6 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and claim the subject matter. Claim 6 has been amended to obviate this rejection.

35 U.S.C. §103 Rejection

Claims 1-10 and 12-14 are rejected as being unpatentable over Hacias (WO 98/23789). This rejection is traversed.

The Patent Office has stated: "Hacias teaches an aqueous metal surface treatment composition comprising ethoxylated aliphatic alcohol having 18-65 carbon atoms (page 8, lines 22-30), phosphate ions in an amount of at least 0.001 moles/l (page 4, lines 11-15)." This statement is incorrect.

The main teaching of Hacias is an aqueous liquid treatment composition comprising water and a combination of: (A) dissolved orthoboric acid; and (B) dissolved condensed phosphoric acids and anions derivable by neutralization thereof. See WO 98/23789, pg. 2, Summary of the Invention.

In a separate section of the publication, WO 98/23789 teaches:

Irrespective of whether or not a wet coating formed by a process according to the invention has been rinsed or not before being dried, the dried coating may be, and usually preferably is, coated with additional lubricant materials known per se in the art before being cold worked. A wide variety of oils and greases, along with other materials, are known for this purpose. A particularly preferred supplemental lubricant of this type includes as a principal constituent ethoxylated straight chain aliphatic alcohol molecules... WO 98/23789, page 8, lines 18-23 (emphasis added).

It is clear from a reading of the above-quoted language, in boldface, that the ethoxylated alcohol is applied in a separate step after the coating containing (A) and (B) is applied and dried.

In the Examples, WO 98/23789 teaches that adding ethoxylated alcohol to its compositions results in precipitation of the bath, an undesirable result, see Example 3.3.

The above portions of WO 98/23789 teach away from the combination proposed by the Patent Office. All rejections under 35 U.S.C. §103 based on WO 98/23789 must be withdrawn.

U.S. Patent No. 5,547,595 to Hacias (the '595 patent), cited by the Patent Office at page 3 of the Official Action mailed May 11, 2007, teaches: (A) ethoxylated straight chain aliphatic alcohol molecules, wherein the initial alcohol molecules have a single --OH moiety and at least 18 carbon atoms; and, optionally but preferably, (B) a component of inorganic boron containing acids or salts thereof, see the '595 patent, col. 3, lines 1-6.

The Hacias references do not teach that the presence of a combination of oxyethylated aliphatic alcohol; dissolved phosphate anions; and a lithium salts, sodium salts, and calcium salts of fatty organic acids, is desirable.

Neither do the Hacias references teach that the presence of a combination of oxyethylated aliphatic alcohol; dissolved phosphate anions; and a lithium salts, sodium salts, and calcium salts of fatty organic acids **in the amounts and ratios**

claimed, are desirable. In particular, there is no teaching or suggestion to include an amount of lithium salts, sodium salts, and calcium salts of fatty organic acids such that this component has a ratio to the oxyethylated aliphatic alcohol that is at least 0.2:1.0 and not more than 10:1.0.

Contrary to the Patent Office position, those of skill in the art would read the following passage as a teaching against use of lithium salts, sodium salts, and calcium salts of fatty organic acids:

For various reasons it is often **preferred that the compositions according to the invention be free from various materials** often used in prior art coating compositions. In particular, compositions according to this invention in most instances preferably contain, with increasing preference in the order given, and with independent preference for each component named, not more than 5, 4, 3, 2, 1, 0.5, 0.25, 0.12, 0.06, 0.03, 0.015, 0.007, 0.003, 0.001, 0.0005, 0.0002, or 0.0001% of each of (i) hydrocarbons, (ii) fatty oils of natural origin, (iii) other ester oils and greases that are liquid at 25.degree. C., (iv) **metal salts of fatty acids**,... WO 98/23789, page 6, line 11-18 and the '595 patent, col. 5, line 66-col. 6, line 9, emphasis added.

Certainly the above-quoted passage does not provide a teaching or suggestion to select particular alkali metal and alkaline earth metals for use in the salts of fatty organic acids, nor do the references provide any motivation to combine the components of claim 1 in the amounts and ratios recited, such as a ratio of the particular fatty acid salts claimed to the oxyethylated aliphatic alcohol that is at least 0.2:1.0 and not more than 10:1.0. Applicant respectfully submit that the claims are patentable over the cited references and request withdrawal of the § 103 rejections.

Conclusion

Applicant requests reconsideration in view of the amendments and remarks contained herein. Applicant submits that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned

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